

REMARKS

This is a full and timely response to the Office Action of July 31, 2006. Reconsideration and allowance of the application and all presently pending claims are respectfully requested.

Upon entry of this Response, claims 1-29 are pending in this application. Claims 9-13 and 18 have been amended. Claims 30-58 are canceled. The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims. Applicants believe that no new matter has been added and that a new search is not necessary.

Claims

35 U.S.C. § 112 Rejection

Claims 1, 7-8, 9-12, and 18-19 have been rejected. Claims 9-12 and 18-19 have been amended. Thus, the rejection of claims 9-12 and 18-19 should be withdrawn.

In regard to claims 1, 7-8, and 11, “d-block” and “f-block” are well known terms that describe the atoms in groups 3-12 of the periodic table, and the lanthanide and actinide series, respectively. Thus, the rejection of claims 1, 7-8, and 11 should be withdrawn.

Applicants wish to clarify that the foregoing amendments have been made for purposes of better defining the invention in response to the rejections made under 35 U.S.C. § 112, and not in response to rejections made based on prior art. Indeed, Applicants submit that no substantive limitations have been added to the claims. Therefore, no prosecution history estoppel arises from these amendments. *Black & Decker, Inc. v. Hoover Svc. Ctr.*, 886 F.2d 1285, 1294 n. 13 (Fed. Cir. 1989); *Andrew Corp. v. Gabriel Elects., Inc.*, 847 F.2d 819 (Fed. Cir. 1988); *Hi-Life Prods. Inc. v. Am. Nat'l. Water-Mattress Corp.*, 842 F.2d 323, 325 (Fed. Cir. 1988); *Mannesmann Demag Corp.*

v. Eng'd Metal Prods. Co., Inc., 793 F.2d 1279, 1284-1285 (Fed. Cir. 1986); *Moeller v. Ionetics, Inc.*, 794 F.2d 653 (Fed. Cir. 1986).

35 U.S.C. § 102 and 103 Rejections

Claims 1-10, 14-19, 24, and 27 stand rejected under 35 U.S.C. §102(a) as allegedly being anticipated by *Okun et al.* Claims 11-13 stand rejected under 35 U.S.C. §103 as allegedly being anticipated by *Okun et al.* in view of WO 99/53131. Claims 20-23, 25-26, and 28-29 stand rejection under 35 U.S.C. §103 as allegedly being anticipated by *Okun et al.* in view of Braue '434. Applicants respectfully traverse these rejections.

All of the joint inventors of the present application are also co-authors of the *Okun et al.* reference. The co-inventor, Craig Hill, has submitted an affidavit under 37 CFR 1.132, attached hereto, alleging that the *Okun et al.* reference is his own work and that the subject matter of the *Okun et al.* reference was carried out in his lab and/or under his supervision.

This situation is directly analogous to that described in *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). In that case, the inventor Katz stated in a declaration that the co-authors of the publication, Chiorazzi and Eshhar, "were students working under the direction and supervision of the inventor, Dr. David H. Katz." *Id.* The court held that this declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work described in the publication was his own. *See id.* The court found that in research papers, students involved only with assay and testing are normally listed as co-authors but are not considered co-inventors. *See id.*; *see also* MPEP §2132.01. Therefore, because Applicants' disclosure of their own work within the year before the

effective filing date (based on the claim of priority to provisional application 60/449,892, filed on February 25, 2003) cannot be used against him or her under 35 U.S.C. 102(a), Applicants respectfully request that the rejections be withdrawn.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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